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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,880	08/04/2003	Philip G. Wessells	20003-7012	5236
35939	7590	09/30/2005	EXAMINER	
MICHAEL E. WOODS PATENT LAW OFFICES OF MICHAEL E. WOODS 112 BARN ROAD TIBURON, CA 94920-2602			HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,880

Applicant(s)

WESSELLS ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 and 37 is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 18 and 23-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date =.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 June 2005 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12, 17, 18, and 23-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-12, 17, 18, 23, 24, 35, and 36 have been amended to recite that forming elements of the apparatus (the scoop and

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former) are "buted-hingedly" coupled together. Claims 25-34 have been amended to recite the similarly in reciting that that second forming element is "buted-moveably" coupled to the shaft.

Applicant notes in the remarks of 09 May 2005, that the term includes the idea that the element does not have a handle or actuator arm extending past the hinge/moving element as is the case as the element "butts" into the hinge/moving element. In the remarks of 25 June 2005 Applicant similarly notes that "buted-hingedly" is used in the sense of a butt-joint or butt hinge, with an example being a hinge composed of two plates attached to abutting surfaces of a door and door jamb and joined by a pin.

The specification of the instant application does not use the term "buted-hingedly." Nor is there any description similar to that assert by Applicant in the remarks with respect to the term.

The drawings of the application are not clear enough to provide support the former butted-hingedly coupled to the scoop. The drawings provided in the file wrapper show darkly shaded figures which do not convey the details of the area of coupling between the former and scoop. The areas do not reveal whether or not an element in any way extends past the coupling, as Applicant suggests the term is intended to mean.

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Thus, as neither the specification, nor the drawings of the originally-filed application describe or show the butted-hingedly relationship between the former and scoop, or similarly, a "butted-moveably" relation between the second forming element and the shaft, the reciting of such relationships present new matter.

Note as well that the term "butted-hingedly" as defined by Applicant includes a negative limitation; that is, the preclusion of an handle or actuator extending past the hinge/moving element. Any negative limitation or exclusionary proviso must have a basis in the originally filed disclosure. The mere absence of a positive recitation is not basis for an exclusion. MPEP § 2173.05(i). The disclosure of the instant application does not describe the lack of a handle, actuator, or other member extending past the hinge/moving element.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-6, 8, 12, 17, 25-28, 30, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Maxwell (U.S. Pat. No. 2,629,344; previously of record).

Maxwell discloses a material forming apparatus. In the embodiment depicted in Figure 3, the apparatus comprises a shaft (22) having a gripping end and a shaping end remote from the gripping end. A shaper (70) is disposed at the distal end, with the shaper including a pair of opposing forming elements (72 and 74) attached to the distal end for relative pivotal motion between them, with the forming elements each including a cavity for shaping a particular material (see Fig. 3). In moving between the open positions and closed positions shown in Fig. 3, the forming elements go through a relative pivotal motion between them of about 180 degrees (about 90 degrees for each section 72 and 74).

Claims of the instant application recite an intended use for the apparatus. Specifically, the apparatus is to be used for collecting and compressing a compressible medium, with the compressible medium more specifically being defined as snow. It is well settled the intended use of an apparatus is not germane to the issue of the patentability of apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d

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576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case Maxwell discloses all of the structural features of the claimed apparatus, and is therefore clearly capable of being used with a compressible material such as snow. Maxwell therefore anticipates the claimed use limitation of the claims.

6. Claims 1-7, 9, 12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Blevins et al. (U.S. Pat. No. 3,509,273; previously of record).

Blevins discloses a snowball forming and ejecting device. The device comprises a shaft (34) having a gripping end (towards element 40) and a distal end, with a scoop (42) coupled to the distal end of the shaft for collecting a bolus of a snow. A scoop (42) including a first cavity is coupled to the distal end of the shaft at an attachment location (see Fig. 2). A former (12) including a second cavity is coupled and mating with the scoop for molding and compressing the snow into a spherical ball retained within the scoop (see Fig. 2 and cl. 2, ll. 34-50). The former is coupled to the scoop "proximate" to the attachment location of the scoop shaft (see Fig. 2 showing the coupling of the scoop and former close or very near the attachment location as compared to the other apparatus elements or structures). The

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device is as such to have a closed position relative to the scoop when the snow is molded in the ball when the scoop and former juxtapose to form a spherical shell (shown in fig. 2), as well as have an open position for releasing the snowball (shown in Fig. 3). Blevins further discloses the apparatus to comprise a latching mechanism (24) for inhibiting the former from moving to an opening position.

7. Applicant's arguments filed 25 June 2005 have been fully considered but they are not persuasive.

Applicant argues that the term "proximate" in describing the relationship of elements of the apparatus (e.g. the scoop relative to the attachment location in claim 1) patentably distinguishes the claims over the prior art of record.

As noted in the previous Office Actions, the term "proximate" must be give its broadest reasonable interpretation. Merriam-Webster's Collegiate Dictionary provides as one definition of proximate as "very near" or "close" (see cited document). The dictionary further notes definitions for the synonyms "proximal" as "close," and "proximity" as "the quality or state of being proximate closeness." Thus, a reasonable interpretation of the term "proximate" is that it conveys the idea of elements being in a near or close relation.

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The prior art used in the rejections describes elements falling within this scope of the term "proximate." Maxwell for example, shows that former and scoop combination (forming elements 72 and 74) very near or close to an attachment location with the shaft (see Fig. 3). Blevins also discloses a close relationship to between the scoop attachment location and the coupling of the former, see for example Fig. 2 showing the proximity of these elements in comparison to the other elements of the apparatus.

It is noted Applicant's argument with respect to the term "proximate" as used in the claims relative to the disclosure of the prior art amounts to a judgment of amount and degree. A general assertion that two elements in the prior art are not "proximate" without providing more of a definitive distinction or definition when the prior art shows the elements to be in a reasonable proximity cannot be used to show patentability over the prior art.


8. Claims 14-16 and 37 are allowed. See the reasons for indicating allowable subject matter in the previous Office Actions.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Primary Examiner
A.U. 1722

9-27-5